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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,548	10/18/2001	Yoshihito Asao	Q66775	5255

7590

02/27/2002

SUGHRUE MION ZINN MACPEAK & SEAS, PLLC
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EXAMINER

NGUYEN, TRAN N

ART UNIT	PAPER NUMBER
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2834

DATE MAILED: 02/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/978,548

Applicant(s)

Examiner

Tran N. Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 2-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 2-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/624,222.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Detailed Office Action

Information Disclosure Statement (IDS)

The information disclosure statement filed 10/18/01 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. The PTO-1449 (IDS form) has been placed in the application file, but the information referred to therein has not been considered because there is no copy of any of the IDS listed references in the file. The applicant is hereby requested to provide *all copies* of the IDS listed references.

Claim Rejections - 35 USC § 112

1. **Claims 2-10** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-8 contains method claimed language which is indefinite because the method claimed language does not further limit the structural limitations in the apparatus claimed invention, but rather reciting the method of forming. In a so-called product-by-process apparatus claimed invention, the method of forming the device is not germane to the issue of patentability of the device itself. (*In re Thorpe*, 227 USPQ 964, 966.)

Double Patenting

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and © may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. **Claims 2-10** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of the U.S. pending patent-application 09/624222 (hereafter, US-PPA '222) in view of Tamaka et al (US 4876473).

US-PPA '222 claimed an alternator substantially as the present claimed invention. While the US-PPA '222 differs from the claimed invention in only two respects that is the claimed invention's stator further comprises an insulating member being interposed between the stator core and the winding.

Tamaka, however, teaches a magnetic core (12) having insulating member made of insulation paper (4) being interposed between the core and the winding (5), wherein the insulating member is a straight base insulating member interposed between the slots and the coils (figs 3a-3b).

Tamaka teaches that insulating member would prevent short-circuiting or grounding of the coil.

Thus, , it would have been obvious to one skilled in the art at the time the invention was made to modify US-PPA '222 by providing an insulating member, made of insulation paper, being interposed between the core and the winding, as taught by Tamaka. Doing so would prevent short-circuiting or grounding of the coil.

Regarding claim 10, the insulating member comprising resin instead of insulation paper, those skilled in the art would realize that resin is widely used and well known in the art as the insulating material for providing insulation between electrical-conductive members as well as

well-known as a insulating bonding material in the art. Tamaka teaches an insulating-paper used as an insulation member being interposed between the slot and winding. Therefore, it would have been obvious to an artisan to apply the Tamaka's teaching with a suitable material selection of an insulating material for the insulation member.

Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select resin as insulating material. Doing so would provide an insulating member that is well-fitted within the slot due to its elastically and adhesive characteristics. Also, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

2. **Claims 2-10** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of the U.S. pending-patent-application 09/734680 (hereafter, US-PPA '680) in view of Adachi (JP 09103052A) and Tamaka et al (US 4876473).

US-PPA'680 claimed an alternator substantially as the present claimed invention. The US-PPA'680 differs from the claimed invention in only three respects:

- (a) the abutting portion making the stator core into an annular shape by abutting end portions of the stator core; and,
- (b) the insulating member interposed between the core and the winding;
- (c) the insulating member is a resin material.

Regarding subsection (a), Adachi, however, teaches an alternator having a stator core with an abutting portion (51b) extending axially for forming the stator core into an annular shape (fig 1-3). Adachi teaches that this configuration of the stator core would facilitate the winding and prevent damage to the conductors of the winding. Furthermore, the Examiner takes Official Notice that magnetic core comprises with axially elongated segment(s) that circumferentially being combined into an annular magnetic core is well known in the art. See cited references for support of this statement.

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Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the alternator by configuring the stator core with an abutting portion extending axially for forming the stator core into an annular shape, as taught by Adachi. Doing so would facilitate the winding and prevent damage to the conductors of the winding.

Regarding subsection (b), Tamaka, however, teaches a magnetic core (12) having insulating member made of insulation paper (4) being interposed between the core and the winding (5), wherein the insulating member is a straight base insulating member interposed between the slots and the coils (figs 3a-3b). Tamaka teaches that insulating member would prevent short-circuiting or grounding of the coil.

Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify US-PPA '680 by providing an insulating member, made of insulation paper, being interposed between the core and the winding, as taught by Tamaka. Doing so would prevent short-circuiting or grounding of the coil.

Regarding subsection (c), the insulating member comprising resin instead of insulation paper, those skilled in the art would realize that resin is widely used and well known in the art as the insulating material for providing insulation between electrical-conductive members as well as well-known as a insulating bonding material in the art. Tamaka teaches an insulating-paper used as an insulation member being interposed between the slot and winding. Therefore, it would have been obvious to an artisan to apply the Tamaka's teaching with a suitable material selection of an insulating material for the insulation member.

Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select resin as insulating material. Doing so would provide an insulating member that is well-fitted within the slot due to its elastically and adhesive characteristics. Also, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

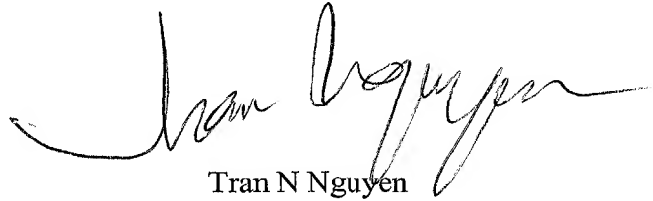
Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran N Nguyen whose telephone number is (703) 308-1639. The examiner can normally be reached on M-F 6:00AM-2:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on (703)-308-1371. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3431 for regular communications and (703)-305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1782.

A handwritten signature in black ink, appearing to read 'Tran N Nguyen', with a long horizontal flourish extending to the right.

Tran N Nguyen

Primary Examiner

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February 25, 2002